



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,504	03/26/2001	Takashi Kawakami	09812.0645-00000	7923

22852 7590 06/29/2006

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

NGUYEN, HUY THANH

ART UNIT	PAPER NUMBER
----------	--------------

2621

DATE MAILED: 06/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/817,504

Applicant(s)

KAWAKAMI ET AL.

Examiner

HUY T. NGUYEN

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-15 and 17 is/are allowed.
- 6) ☒ Claim(s) 1-2, 16 and 18 is/are rejected.
- 7) ☒ Claim(s) 3-8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1 –2,16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanda (5,930,446) in view of Furuyama .

Regarding claims 1,2 and 18, Kanda discloses an editing apparatus for editing coded data in a predetermined unit to be stored into a storage medium, comprising:

designation means for designating an editing position (start or in point)(Figs.3, 12-13) of the coded data;

evaluation means (11) for evaluating a playback state when the coded data are played back from the editing position designated by said designation means (column 10 ; and

notification means (display means) for notifying a user of said editing apparatus of an evaluation result by said evaluation means (Fig. 3, column 7, lines 50-65).

Kanda fails to teach that the evaluation means outputs, as the evaluation result, a playback standby time (waiting time) required to start playback outputting after an instruction to play back and output the coded data from the editing position is issued .

Furuyama teaches an evaluation means for outputting a playback standby time (waiting time) required to start playback outputting after an instruction to play back and output the coded data from the editing position is issued (column 10).

It would have been obvious to one of ordinary skill in the art to modify Kanda with Furuyama by using an evaluation means as taught by Furuyama with the apparatus of Kanda for generating and outputting a playback standby time thereby accurately editing the data .

Method claim 16 corresponds to apparatus claim 1. Therefore method claim 16 is rejected by the same reason as applied to apparatus claim 1.

Applicant argues that "The Examiner relies on column 10 of Furuyama for allegedly teaching an evaluation means for outputting a playback standby time (waiting time) required to start playback outputting after an instruction to play back" (Office Action at page 4). Applicants respectfully disagree. This passage of Furuyama discloses

Art Unit: 2621

a point on the magnetic tape that is a point preceding the cut-in timing by a length of time necessary before the travel of the tape is stabilized to give an adequate state of reproduction (and) is displayed in a blinking manner in such a manner as -:-:-" (col. 10, lines 1-7). A count value "nsec" indicates the cut-in timing point on the tape, and a flow of the operation in a state of waiting for settling action on the count value of a cut-out point is indicated by "a blinking display of-:-:-" (col. 10, lines 24-30 and Fig. 6B).

The blinking display, of Furuyama, shows that the flow of operation is in a state of waiting (col. 11, lines 26-27). This display is not used in evaluating a playback state. Therefore, Furuyama does not teach an "evaluation means for evaluating a playback state according to a playback standby time required to start playback after an instruction to play back the coded data from the editing position designated by said designation means", as recited in claim 1."

In response, the examiner disagrees. The blinking display as taught by Furuyama is considered as an evaluation of a playback state according to an playback standby since it indicates a playback standby time required from receiving an editing instruction to playing back the data on a tape at an edition position (cut in point). The waiting time is a standby time for a playback from a edition point.

Allowable Subject Matter

3. Claims 3- 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
4. Claims 9-15 and 17 are allowed.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T. NGUYEN whose telephone number is (571) 272-7378. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

H.N

HUY NGUYEN
PATENT EXAMINER